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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,233	10/26/2000	Joseph T. Pych	NMC-003.01	3470

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EXAMINER
ROBINSON BOYCE, AKIBA K

ART UNIT	PAPER NUMBER
3639	

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 June 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14,17,18,33-43,45-53,56 and 57* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14,17,18,33-43,45-53,56 and 57* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>062705</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   Due to communications filed 6/27/05, the following is a non-final office action.

Claims 15, 16, 19-32, 44, 54-55 and 58 are cancelled. Claims 1-3, 5, 14, 17, 33-39 and

42-43 have been amended. Claims 1-14, 17, 18, 33-43, 45-53, 56 and 57 are pending

in this application and have been examined on the merits. The previous rejection has

been withdrawn and the following reflects the claims as amended. Claims 1-14, 17, 18,

33-43, 45-53, 56 and 57 are rejected as follows.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1, 3-9, 11-14, 17, 18, are rejected under 35 U.S.C. 103(a) as being

unpatentable over Saxe (US 5,636,346), and further in view of Heinly (NAHB Conferees

Explore strategies to cope with a market revolution).

As per claim 1, Saxe discloses:

Providing a computer-readable database of prospect lists, in which each

prospect list is associated with (i)at least one list purchaser who used the prospect list

and, (Col. 12, lines 42-45, [matching with the database to identify target subscriber

listing]) (ii) for each list purchaser who used the prospect list, data that indicates

whether the list was successful based on feedback from the list purchaser, (Col. 8, lines

59-65, [subscriber responses provided represents feedback, list of respondees to

targeted advertisements identified by a buy number who desire product information

indicates a successful list], also, col. 11, lines 18-19, list of American Express

Cardholders, w/ col. 11, lines 19-23, where "matching" results in identifying which

cardholders on the list is successful since cardholders are being matched with lists of

gold card holders which are analogous to successful lists since these cardholders have

successfully been upgraded from green to gold, w/ col. 11, lines 33-48, shows that the

advertising agency provides findings about cardholders who can be targeted with

premium or gold credit card offers (successful lists) using a continuous series of

advertisements regarding credit card upgrades are held in the TEA system as pending

buys for American express. In this case, customers who are already card holders have

already been used by American express to obtain a credit card (and are therefore

already successful), and are being used again for upgrades, and therefore the

information about cardholders that is input into the TEA system represents feedback

since these cardholders have already been used previously by the American Express

List purchasers through advertising in order to make them green cardholders).

Using a computer system to:

Identify, in the database of prospect lists, one or more successful lists of

prospective customers in which each such list was used by the first list purchaser and is

associated with data indicating that the list was successful for the first list purchaser

based on feedback from the first list purchaser, (Col. 12, lines 42-45, [matching with the

database to identify target subscriber listing where the subscriber represents the customer], Col. 8, lines 48-65, [viewers {subscribers} may interface with the cable medium in order to interact where appropriate, and responses are captured on a file server, thereby allowing viewer {subscriber} access to this response information. In addition, the subscriber responses provided represents feedback, and the list of respondees to targeted advertisements identified by a buy number who desire product information indicates a successful list], also, Col. 11, lines 19-23, matching the cardholder profile with a list of consumers from the gold list having similar characteristics, where the gold list is the successful list);

For each of the at least one other list purchaser, identify, in the database of prospect lists, one or more successful lists of prospective customers in which each such list was used by the list purchaser and is associated with data indicating that the list was successful for the list purchaser based on feedback from the list purchaser, (Col. 8, lines 48-65, [shows that viewers {subscribers} may interface with the cable medium in order to interact where appropriate, and responses are captured on a file server, thereby allowing viewer {subscriber} access to this response information. In addition, the subscriber responses provided represents feedback, and the list of respondees to targeted advertisements identified by a buy number who desire product information indicates a successful list], col. 11, lines 33-48, shows that the advertising agency provides findings about cardholders who can be targeted with premium or gold credit card offers (successful lists) using a continuous series of advertisements regarding credit card upgrades are held in the TEA system as pending buys for American express.

In this case, customers who are already card holders have already been used by American express to obtain a credit card (and are therefore already successful), and are being used again for upgrades, and therefore the information about cardholders that is input into the TEA system represents feedback since these cardholders have already been used previously by the American Express List purchasers through advertising in order to make them green cardholders); and

provide access to the first list purchaser to a targeted list of prospective customers, the targeted list including one or more of the successful lists of prospective customers identified for the first list purchaser and one or more of the successful lists identified for at least one of the at least one other list purchasers, (Col. 13, lines 37-50, [producing a target subscriber list from a subset], Col. 13, lines 60-62, [transmitting the commercial information [represents the list]).

Saxe does not specifically disclose "identify, from the database of prospect lists, at least one other list purchaser who used one or more of the one or more successful lists identified for the first list purchaser". However, Saxe would have incorporated this feature with the motivation of submitting a successfully represented list that reflects products or services that customers "would purchase" and that purchasers have previously used.

However, Heinly discloses:

identify, from the database of prospect lists, at least one other list purchaser who used one or more of the one or more successful lists identified for the first list

purchaser, (Page 2, paragraph 14, lines 1-2, [maintaining a "prospect list" of former customers and of nonbuying "traffic" to target potential buyers]).

Heinly incorporated the above limitation in an analogous art for the purpose of showing that a prospect list can be determined from previous successful lists such as prospect lists of former customers.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to identify from the database of prospect lists, at least one other list purchaser who used one or more of the one or more successful lists identified for the first list purchaser with the motivation of using list purchasers to find prospect customers that would purchase certain product and services, and would be the best candidates to target.

As per claim 3, Saxe discloses:

remove duplicate prospective customers from the targeted list of prospective customers, (Col. 10, line 48, [eliminating duplicate list]).

As per claim 4, Saxe discloses:

wherein the database of prospective customers is a computer database available over a computer network via client computers to a plurality of list purchasers, (Fig. 1).

As per claim 5, Saxe discloses:

distribute the targeted list of prospective customers to the first list purchaser, (Col. 3, lines 3-13, [distributors advertising messages and accessing targeted subscribers]).

As per claims 6, Saxe discloses:

distributing the targeted list of prospective customers to a third party associated

with the first list purchaser,(Col. 13, lines 8-61, [shows process for third party source]).

As per claim 7, Saxe discloses:

wherein the third party contacts prospective customers on behalf of the first list

purchaser, (Col. 13, lines 63-67, [arranging for the transmission]).

As per claim 8, Saxe discloses:

wherein the third party stores the targeted list of prospective customers on a

storage medium and delivers the storage medium to the first list purchaser, (Col. 4, lines

7-14, [subscriber data stored]).

As per claim 9, Saxe discloses:

Communicate with a database of prospect lists, in which each prospect list is

associated with (i) at least one list purchaser who used the prospect list and (ii) for each

list purchaser who used the prospect list data that indicated whether the list was

successful based on feedback from the list purchaser, (Col. 12, lines 42-45, [matching

with the database to identify target subscriber listing]) (ii) for each list purchaser who

used the prospect list, data that indicates whether the list was successful based on

feedback from the list purchaser, (Col. 8, lines 59-65, [subscriber responses provided

represents feedback, list of respondees to targeted advertisements identified by a buy

number who desire product information indicates a successful list], col. 11, lines 18-19,

list of American Express Cardholders, w/ col. 11, lines 19-23, where "matching" results

in identifying which cardholders on the list is successful since cardholders are being

matched with lists of gold card holders which are analogous to successful lists since

these cardholders have successfully been upgraded from green to gold, w/ col. 11, lines 33-48, shows that the advertising agency provides findings about cardholders who can be targeted with premium or gold credit card offers (successful lists) using a continuous series of advertisements regarding credit card upgrades are held in the TEA system as pending buys for American express. In this case, customers who are already card holders have already been used by American express to obtain a credit card (and are therefore already successful), and are being used again for upgrades, and therefore the information about cardholders that is input into the TEA system represents feedback since these cardholders have already been used previously by the American Express List purchasers through advertising in order to make them green cardholders);

identify, in the database of prospect lists, one or more successful lists of prospective customers in which each such list was used by a first list purchaser and is associated with data indicating that the list was successful for the first list purchased based on feedback from the first list purchaser, (Col. 12, lines 42-45, [matching with the database to identify target subscriber listing, (Col. 12, lines 42-45, [matching with the database to identify target subscriber listing where the subscriber represents the customer], Col. 8, lines 48-65, [viewers {subscribers} may interface with the cable medium in order to interact where appropriate, and responses are captured on a file server, thereby allowing viewer {subscriber} access to this response information. In addition, the subscriber responses provided represents feedback, and the list of respondees to targeted advertisements identified by a buy number who desire product information indicates a successful list], Col. 11, lines 19-23, matching the cardholder

profile with a list of consumers from the gold list having similar characteristics, where

the gold list is the successful list);

for each of the at least one other list purchaser, identify, in the database of

prospect lists, one or more successful lists of prospective customers in which each such

list was used by the list purchaser and is associated with data indicating that the list was

successful for the list purchaser based on feedback from the list purchaser, (Col. 8,

lines 48-65, [shows that viewers {subscribers} may interface with the cable medium in

order to interact where appropriate, and responses are captured on a file server,

thereby allowing viewer {subscriber} access to this response information. In addition,

the subscriber responses provided represents feedback, and the list of respondees to

targeted advertisements identified by a buy number who desire product information

indicates a successful list], col. 11, lines 33-48, shows that the advertising agency

provides findings about cardholders who can be targeted with premium or gold credit

card offers (successful lists) using a continuous series of advertisements regarding

credit card upgrades are held in the TEA system as pending buys for American express.

In this case, customers who are already card holders have already been used by

American express to obtain a credit card (and are therefore already successful), and are

being used again for upgrades, and therefore the information about cardholders that is

input into the TEA system represents feedback since these cardholders have already

been used previously by the American Express List purchasers through advertising in

order to make them green cardholders);

provide access to the first list purchaser to a targeted list of prospective

customers, the targeted list including one or more of the successful lists of prospective

customers identified for the first list purchaser and one or more of the successful lists

identified for at least one of the at least one other list purchasers, (Col. 13, lines 37-50,

[producing a target subscriber list from a subset], Col. 13, lines 60-62, [transmitting the

commercial information [represents the list]).

Saxe does not specifically disclose "identify from the database of prospect lists,

at least one other list purchaser who used one or more of the one or more successful

lists identified for the first list purchaser". However, Saxe would have incorporated this

feature with the motivation of submitting a successfully represented list that reflects

products or services that customers "would purchase" and that purchasers have

previously used.

However, Heinly discloses:

identify from the database of prospect lists, at least one other list purchaser who

used one or more of the one or more successful lists identified for the first list

purchaser, (Page 2, paragraph 14, lines 1-2, [maintaining a "prospect list" of former

customers and of nonbuying "traffic" to target potential buyers]).

Heinly incorporated the above limitation in an analogous art for the purpose of

showing that a prospect list can be determined from previous successful lists such as

prospect lists of former customers.

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to identify from the database of prospect lists, at least one other list

purchaser who used one or more of the one or more successful lists identified for the

first list purchaser with the motivation of using list purchasers to find prospect customers

that would purchase certain product and services, and would be the best candidates to

target.

As per claim 11, Saxe discloses:

remove duplicate prospective customers from the targeted list of prospective

customers, (Col. 10, line 48, [eliminating duplicate list]).

As per claim 12, Saxe discloses:

wherein the database is a computer database of prospective customers available

over a computer network via client computers to a plurality of list purchasers, (Fig. 1).

As per claim 13, Saxe discloses:

wherein the database of prospective customers is coupled to the computer over

a computer network, (Fig. 1).

As per claim 14, Saxe discloses:

a database of prospect lists, in which each prospect list is associated with (i) at

least one list purchaser who used the prospect list, (Col. 12, lines 32-45, [matching with

the database to identify target subscriber listing]) and (ii) for each list purchaser who

used the prospect list, data that indicates whether the list was successful based on

feedback from the list purchaser; (Col. 8, lines 59-65, [subscriber responses provided

represents feedback, list of respondees to targeted advertisements identified by a buy

number who desire product information indicates a successful list], col. 11, lines 18-19,

list of American Express Cardholders, w/ col. 11, lines 19-23, where "matching" results

in identifying which cardholders on the list is successful since cardholders are being

matched with lists of gold card holders which are analogous to successful lists since

these cardholders have successfully been upgraded from green to gold, w/ col. 11, lines

33-48, shows that the advertising agency provides findings about cardholders who can

be targeted with premium or gold credit card offers (successful lists) using a continuous

series of advertisements regarding credit card upgrades are held in the TEA system as

pending buys for American express. In this case, customers who are already card

holders have already been used by American express to obtain a credit card (and are

therefore already successful), and are being used again for upgrades, and therefore the

information about cardholders that is input into the TEA system represents feedback

since these cardholders have already been used previously by the American Express

List purchasers through advertising in order to make them green cardholders);

a server computer configured to provide the prospect list to a plurality of list

purchasers via client computers, (col. 8, line 52, file server) by:

Identifying, in the database of prospect lists, at least one other list purchaser who

used on e or more of the one or more successful lists identified for the first list

purchaser, (Col. 12, lines 42-45, [matching with the database to identify target

subscriber listing, (Col. 12, lines 42-45, [matching with the database to identify target

subscriber listing where the subscriber represents the customer], Col. 8, lines 48-65,

[viewers {subscribers} may interface with the cable medium in order to interact where

appropriate, and responses are captured on a file server, thereby allowing viewer

{subscriber} access to this response information. In addition, the subscriber responses

provided represents feedback, and the list of respondees to targeted advertisements

identified by a buy number who desire product information indicates a successful list],],

Col. 11, lines 19-23, matching the cardholder profile with a list of consumers from the

gold list having similar characteristics, where the gold list is the successful list);

For each of the at least one other list purchaser, identify, in the database of

prospect lists, one or more successful lists of prospective customers in which each such

list was used by the list purchaser and is associated with data indicating that the list was

successful for the list purchaser based on feedback for the list purchaser, (Col. 8, lines

48-65, [shows that viewers {subscribers} may interface with the cable medium in order

to interact where appropriate, and responses are captured on a file server, thereby

allowing viewer {subscriber} access to this response information. In addition, the

subscriber responses provided represents feedback, and the list of respondees to

targeted advertisements identified by a buy number who desire product information

indicates a successful list], col. 11, lines 33-48, shows that the advertising agency

provides findings about cardholders who can be targeted with premium or gold credit

card offers (successful lists) using a continuous series of advertisements regarding

credit card upgrades are held in the TEA system as pending buys for American express.

In this case, customers who are already card holders have already been used by

American express to obtain a credit card (and are therefore already successful), and are

being used again for upgrades, and therefore the information about cardholders that is

input into the TEA system represents feedback since these cardholders have already

been used previously by the American Express List purchasers through advertising in

order to make them green cardholders); and

Providing access to the first list purchaser to a targeted list of prospective

customers, the targeted list including one or more of the successful list of prospective

customers identified for the first list purchaser and one or more of the successful lists

identified for at least one of the at least one other list purchaser, (Col. 13, lines 37-50,

[producing a target subscriber list from a subset], Col. 13, lines 60-62, [transmitting the

commercial information [represents the list]).

Saxe fails to disclose "identify in the database of prospect lists, at least one

other list purchaser who used one or more of the one or more successful lists identified

for the first list purchaser". However, Saxe would have incorporated this feature with

the motivation of submitting a successfully represented list that reflects products or

services that customers "would purchase" and that purchasers have previously used.

However, Heinly discloses:

identify in the database of prospect lists, at least one other list purchaser who

used one or more of the one or more successful lists identified for the first list

purchaser, (Page 2, paragraph 14, lines 1-2, [maintaining a "prospect list" of former

customers and of nonbuying "traffic" to target potential buyers]).

Heinly incorporated the above limitation in an analogous art for the purpose of

showing that a prospect list can be determined from previous successful lists such as

prospect lists of former customers.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to identify in the database of prospect lists, at least one other list purchaser who used one or more of the one or more successful lists identified for the first list purchaser with the motivation of using list purchasers to find prospect customers that would purchase certain product and services, and would be the best candidates to target.

As per claim 17, Saxe discloses:

wherein the prospect list identifies at least one of the at least one list purchaser based on additional predetermined criteria relating the at least one of the at least one other list purchaser to the first list purchaser, (Col. 7, lines 5-7, [preselected criteria]).

As per claim 18, Saxe discloses:

wherein the predetermined criteria concerns a business of the first list purchaser and the at least one of the at least one other list purchaser, (Col. 7, lines 7-9, [trading area]).

4.   Claims 2, 10, 36, 48, 53, 56-57, are rejected under 35 U.S.C. 103(a) as being unpatentable over Saxe (US 5,636,346), and further in view of Heinly (NAHB Conferees Explore Strategies to Cope With a Market Revolution), and further view of Wright et al (US 6,004,276).

As per claim 2, both Saxe and Heinly fail to disclose using the computer system to rank the prospect lists identified in the database and associated with the at least one other list purchaser based on predetermined factors. Saxe and Heinly would have

included ranking the prospect list with the motivation of arranging customer requests/orders in an order that would allow the user to identify the most relevant request/order.

However Wright et al discloses:

Using the computer system to rank the prospect lists identified in the database and associated with the at least one other list purchaser based on predetermined factors, (Col. 125, lines 43-45, [records according to hierarchy]).

Wright shows the above limitation in an analogous art for the purpose of arranging electronic records according to uniquely identify a record to be ordered.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to rank the prospect lists identified with the motivation of accurately associating prospect lists that accommodate specific purchasers.

As per claim 10, both Saxe and Heinly fail to disclose rank the prospect lists identified from the database based on predetermined factors to identify prospect lists most relevant to the first list purchaser. Saxe and Heinly would have included ranking the prospect list with the motivation of arranging customer requests/orders in an order that would allow the user to identify the most relevant request/order.

However Wright et al discloses:

rank the prospect lists identified from the database based on predetermined factors to identify prospect lists most relevant to the first list purchaser, (Col. 125, lines 43-45, [records according to hierarchy]).

Wright shows the above limitation in an analogous art for the purpose of arranging electronic records according to uniquely identify a record to be ordered.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to rank the prospect lists identified with the motivation of accurately associating prospect lists that accommodate specific purchasers.

As per claim 36, both Saxe and Heinly fail to disclose using the computer system to rank the at least one other prospect list identified in the computer database based on predetermined factors. Saxe and Heinly would have included ranking the prospect list with the motivation of arranging customer requests/orders in an order that would allow the user to identify the most relevant request/order.

However Wright et al discloses:

Using the computer system to rank the at least one other prospect list identified in the computer database based on predetermined factors, (Col. 125, lines 43-45, [records according to hierarchy]).

Wright shows the above limitation in an analogous art for the purpose of arranging electronic records according to uniquely identify a record to be ordered.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to rank the prospect lists identified with the motivation of accurately associating prospect lists that accommodate specific purchasers.

As per claim 48, both Saxe and Heinly fail to disclose rank the at least one other prospect list identified in the computer database based on predetermined factors. Saxe and Heinly would have included ranking the prospect list with the motivation of

arranging customer requests/orders in an order that would allow the user to identify the most relevant request/order.

However Wright et al discloses:

rank the at least one other prospect list identified in the computer database based on predetermined factors, (Col. 125, lines 43-45, [records according to hierarchy]).

Wright shows the above limitation in an analogous art for the purpose of arranging electronic records according to uniquely identify a record to be ordered.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to rank the prospect lists identified with the motivation of accurately associating prospect lists that accommodate specific purchasers.

As per claim 53, Saxe discloses:

means for storing a database of prospect lists, (Col. 14, lines 29-31, [means recorded on said recording medium for creating a database])in which each prospect list is associated with (i) at least one list purchaser who used the prospect list, (Col. 12, lines 32-45, [matching with the database to identify target subscriber listing]) and (ii) for each list purchaser who used the prospect list, data that indicates whether the list was successful based on feedback from the list purchaser, (Col. 8, lines 59-65, [subscriber responses provided represents feedback, list of respondees to targeted advertisements identified by a buy number who desire product information indicates a successful list], col. 11, lines 18-19, list of American Express Cardholders, w/ col. 11, lines 19-23, where "matching" results in identifying which cardholders on the list is successful since

cardholders are being matched with lists of gold card holders which are analogous to successful lists since these cardholders have successfully been upgraded from green to gold, w/ col. 11, lines 33-48, shows that the advertising agency provides findings about cardholders who can be targeted with premium or gold credit card offers (successful lists) using a continuous series of advertisements regarding credit card upgrades are held in the TEA system as pending buys for American express. In this case, customers who are already card holders have already been used by American express to obtain a credit card (and are therefore already successful), and are being used again for upgrades, and therefore the information about cardholders that is input into the TEA system represents feedback since these cardholders have already been used previously by the American Express List purchasers through advertising in order to make them green cardholders);

means for providing a user interface comprising controls whereby a list purchaser can access information concerning prospect lists stored in the database, ([cable medium]);

means for generating the targeted list for the first list purchaser, (col. 14, lines 47-53, [means for controlling the transmission to target subscribers], the means being configured to:

Identify, in the database of prospect lists, at least one other list purchaser who used on e or more of the one or more successful lists identified for the first list purchaser, (Col. 12, lines 42-45, [matching with the database to identify target subscriber listing, (Col. 12, lines 42-45, [matching with the database to identify target

subscriber listing where the subscriber represents the customer], Col. 8, lines 48-65,

[viewers {subscribers} may interface with the cable medium in order to interact where

appropriate, and responses are captured on a file server, thereby allowing viewer

{subscriber} access to this response information. In addition, the subscriber responses

provided represents feedback, and the list of respondees to targeted advertisements

identified by a buy number who desire product information indicates a successful list],

Col. 11, lines 19-23, matching the cardholder profile with a list of consumers from the

gold list having similar characteristics, where the gold list is the successful list);

For each of the at least one other list purchaser, identify, in the database of

prospect lists, one or more successful lists of prospective customers in which each such

list was used by the list purchaser and is associated with data indicating that the list was

successful for the list purchaser based on feedback for   the list purchaser, (Col. 8, lines

48-65, [shows that viewers {subscribers} may interface with the cable medium in order

to interact where appropriate, and responses are captured on a file server, thereby

allowing viewer {subscriber} access to this response information. In addition, the

subscriber responses provided represents feedback, and the list of respondees to

targeted advertisements identified by a buy number who desire product information

indicates a successful list], col. 11, lines 33-48, shows that the advertising agency

provides findings about cardholders who can be targeted with premium or gold credit

card offers (successful lists) using a continuous series of advertisements regarding

credit card upgrades are held in the TEA system as pending buys for American express.

In this case, customers who are already card holders have already been used by

American express to obtain a credit card (and are therefore already successful), and are being used again for upgrades, and therefore the information about cardholders that is input into the TEA system represents feedback since these cardholders have already been used previously by the American Express List purchasers through advertising in order to make them green cardholders); and

Provide access to the first list purchaser to a targeted list of prospective customers, the targeted list including one or more of the successful list of prospective customers identified for the first list purchaser and one or more of the successful lists identified for at least one of the at least one other list purchaser, (Col. 13, lines 37-50, [producing a target subscriber list from a subset], Col. 13, lines 60-62, [transmitting the commercial information [represents the list]).

Saxe fails to disclose a network interface for connecting the computer system to a computer network, the computer system being accessible over the computer network via client computers to a plurality of list purchasers. Saxe would have included this limitation with the motivation of showing a means or some type of specific hardware for providing an interface.

However Wright et al discloses:

a network interface for connecting the computer system to a computer network, the computer system being accessible over the computer network via client computers to a plurality of list purchasers, (Col. 29, line 65, [inter-network interface]).

Wright et al shows the above limitation in an analogous art for the purpose of showing the specific piece of hardware used to create the interface environment.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have a network interface for connecting the computer system to a computer network to the computer system being accessible over the computer network via client computers to a plurality of list purchasers with the motivation of providing a connection point for interfacing with the internet.

Saxe fails to disclose "identify in the database of prospect lists, at least one other list purchaser who used one or more of the one or more successful lists identified for the first list purchaser". However, Saxe would have incorporated this feature with the motivation of submitting a successfully represented list that reflects products or services that customers "would purchase" and that purchasers have previously used.

However, Heinly discloses:

identify in the database of prospect lists, at least one other list purchaser who used one or more of the one or more successful lists identified for the first list purchaser, (Page 2, paragraph 14, lines 1-2, [maintaining a "prospect list" of former customers and of nonbuying "traffic" to target potential buyers]).

Heinly incorporated the above limitation in an analogous art for the purpose of showing that a prospect list can be determined from previous successful lists such as prospect lists of former customers.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to identify in the database of prospect lists, at least one other list purchaser who used one or more of the one or more successful lists identified for the first list purchaser with the motivation of using list purchasers to find prospect customers

that would purchase certain product and services, and would be the best candidates to

target.

As per claim 56, Saxe discloses:

wherein the means for generating the targeted list is configured to identify at

least one of the at least one other list purchaser based on additional predetermined

criteria relating the at least one of the at least one other list purchaser to the first list

purchaser, (Col. 7, lines 5-7, [preselected criteria]).

As per claim 57, Saxe discloses:

wherein the predetermined criteria concerns a business of the first list purchaser

and the at least one of the at least one other list purchaser, (Col. 7, lines 7-9, [trading

area]).

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.   Claims 33-35, 37-43, 45-47, 49-51, are rejected under 35 U.S.C. 102(b) as being

anticipated by Saxe (US 5,636,346).

As per claim 33, Saxe discloses:

Using a computer system to:

identify, in a computer database of prospect lists, a successful list of prospective

customers that was used by the first list purchaser and that is associated with data

indicating that the list was successful for the first list purchaser based on feedback from

the first list purchaser, (Col. 12, lines 32-45, [matches with the database to identify

target subscriber listing, (Col. 8, lines 59-65, [subscriber responses provided represents

feedback, list of respondees to targeted advertisements identified by a buy number who

desire product information indicates a successful list], col. 11, lines 18-19, list of

American Express Cardholders, w/ col. 11, lines 19-23, where "matching" results in

identifying which cardholders on the list is successful since cardholders are being

matched with lists of gold card holders which are analogous to successful lists since

these cardholders have successfully been upgraded from green to gold, w/ col. 11, lines

33-48, shows that the advertising agency provides findings about cardholders who can

be targeted with premium or gold credit card offers (successful lists) using a continuous

series of advertisements regarding credit card upgrades are held in the TEA system as

pending buys for American express. In this case, customers who are already card

holders have already been used by American express to obtain a credit card (and are

therefore already successful), and are being used again for upgrades, and therefore the

information about cardholders that is input into the TEA system represents feedback

since these cardholders have already been used previously by the American Express

List purchasers through advertising in order to make them green cardholders);

identify, in the computer database, at least one other prospect list that includes at

least one of the prospective customers included in the successful list of prospective

customers for the first list purchaser, (Col. 12, lines 48-51, [commercial information

being transmitted to the subscriber], (Col. 13, lines 42-50, [where successful prospect

lists are represented by the target subscriber lists that matches the customer

information], (Col. 12, lines 42-45, [matching with the database to identify target

subscriber listing where the subscriber represents the customer], Col. 8, lines 48-65,

[viewers {subscribers} may interface with the cable medium in order to interact where

appropriate, and responses are captured on a file server, thereby allowing viewer

{subscriber} access to this response information. In addition, the subscriber responses

provided represents feedback, and the list of respondees to targeted advertisements

identified by a buy number who desire product information indicates a successful list],

col. 11, lines 33-48, shows that the advertising agency provides findings about

cardholders who can be targeted with premium or gold credit card offers (successful

lists) using a continuous series of advertisements regarding credit card upgrades are

held in the TEA system as pending buys for American express. In this case, customers

who are already card holders have already been used by American express to obtain a

credit card (and are therefore already successful), and are being used again for

upgrades, and therefore the information about cardholders that is input into the TEA

system represents feedback since these cardholders have already been used

previously by the American Express List purchasers through advertising in order to

make them green cardholders); and

    provide access to a targeted list of prospective customers, including one or more

prospective customers from the set of additional prospect list, to the first list purchaser,

(Col. 13, lines 37-50, [producing a target subscriber list from a subset], Col. 13, lines 60-62, [transmitting the commercial information [represents the list]).

As per claim 34, Saxe discloses:

wherein each of the prospective customers stored in the computer database is assigned a unique known party ID, (Col. 4, line 49, [subscriber customer identification])and wherein using the computer system to identify the at least one other prospect list includes using the computer system to:

identify, in the database, prospective customers that have the same known party ID as the known party ID assigned to at least one of the prospective customers from the successful list of prospective customers for the first list purchaser, (col. 4, line 55-col. 5, line 9, (matching identification to define more targeted audience]).

As per claim 35, Saxe discloses:

Identify, in the database, prospective customers having at least one attribute similar to at least one attribute of at least one of the prospective customers from the successful list of prospective customers for the first list purchaser, (Col. 11, lines 19-23, [similar characteristics]).

As per claim 37, Saxe discloses:

remove duplicate prospective customers from the targeted list of prospective customers, (Col. 10, line 48, [eliminate duplicate list]).

As per claim 38, Saxe discloses:

distribute the targeted list of prospective customers to the first list purchaser,

(Col. 3, lines 3-13, [distributors advertising messages and accessing targeted

subscribers]).

As per claim 39, Saxe discloses:

distribute the targeted list of prospective customers to a third party associated

with the first list purchaser, (Col. 13, lines 8-61, [shows process for third party source]).

As per claim 40, Saxe discloses:

wherein the third party contacts prospective customers on behalf of the first list

purchaser, (Col. 13, lines 63-67, [arranging for the transmission]).

As per claim 41, Saxe discloses:

wherein the third party stores the targeted list of prospective customers on a

storage medium and delivers the storage medium to the first list purchaser, (Col. 4, lines

7-14, [subscriber data stored]).

As per claim 42, Saxe discloses:

solicit feedback from the first list purchaser to evaluate success of the targeted

list provided to the first list purchaser, (Col. 6, lines 42-45, [shows directory's information

can come from local surveys)].

As per claim 43, Saxe discloses:

Store the feedback from the first list purchaser in the computer database, (Col. 6,

line 37, [shows survey information is updated in the directory]).

As per claim 45, Saxe discloses:

identify, in a computer database of prospect lists, a successful list of prospective

customers that was used by the first list purchaser and that is associated with data

indicating that the list was successful for the first list purchaser based on feedback from

the first list purchaser, (Col. 12, lines 42-45, [matching with the database to identify

target subscriber listing], w/(Col. 12, lines 32-45, [matches with the database to identify

target subscriber listing, (Col. 8, lines 59-65, [subscriber responses provided represents

feedback, list of respondees to targeted advertisements identified by a buy number who

desire product information indicates a successful list], col. 11, lines 18-19, list of

American Express Cardholders, w/ col. 11, lines 19-23, where "matching" results in

identifying which cardholders on the list is successful since cardholders are being

matched with lists of gold card holders which are analogous to successful lists since

these cardholders have successfully been upgraded from green to gold, w/ col. 11, lines

33-48, shows that the advertising agency provides findings about cardholders who can

be targeted with premium or gold credit card offers (successful lists) using a continuous

series of advertisements regarding credit card upgrades are held in the TEA system as

pending buys for American express. In this case, customers who are already card

holders have already been used by American express to obtain a credit card (and are

therefore already successful), and are being used again for upgrades, and therefore the

information about cardholders that is input into the TEA system represents feedback

since these cardholders have already been used previously by the American Express

List purchasers through advertising in order to make them green cardholders);

identify, in the computer database, at least one other prospect list that includes at

least one of the prospective customers included in the successful list of prospective

customers for the first list purchaser, (Col. 12, lines 46-47, (providing control signal for

subscriber [represents the list purchaser], (Col. 13, lines 42-50, [where successful

prospect lists are represented by the target subscriber lists that matches the customer

information], w/(Col. 12, lines 48-51, [commercial information being transmitted to the

subscriber], (Col. 13, lines 42-50, [where successful prospect lists are represented by

the target subscriber lists that matches the customer information], (Col. 12, lines 42-45,

[matching with the database to identify target subscriber listing where the subscriber

represents the customer], Col. 8, lines 48-65, [viewers {subscribers} may interface with

the cable medium in order to interact where appropriate, and responses are captured on

a file server, thereby allowing viewer {subscriber} access to this response information.

In addition, the subscriber responses provided represents feedback, and the list of

respondees to targeted advertisements identified by a buy number who desire product

information indicates a successful list], col. 11, lines 33-48, shows that the advertising

agency provides findings about cardholders who can be targeted with premium or gold

credit card offers (successful lists) using a continuous series of advertisements

regarding credit card upgrades are held in the TEA system as pending buys for

American express. In this case, customers who are already card holders have already

been used by American express to obtain a credit card (and are therefore already

successful), and are being used again for upgrades, and therefore the information about

cardholders that is input into the TEA system represents feedback since these

cardholders have already been used previously by the American Express List

purchasers through advertising in order to make them green cardholders); and

provide access to a targeted list of prospective customers, including one or more

prospective customers from the set of additional prospect list, to the first list purchaser,

(Col. 12, lines 48-51, [commercial information being transmitted to the subscriber],

w/(Col. 13, lines 37-50, [producing a target subscriber list from a subset], Col. 13, lines

60-62, [transmitting the commercial information [represents the list]).

As per claim 46, Saxe discloses:

wherein each of the prospective customers stored in the computer database is

assigned a unique known party ID, (Col. 4, line 49, [subscriber customer identification])

and further comprising processing instructions for directing the computer to

identify prospective customers stored in the database having the known party

assigned to prospective customers from the successful list of the first list purchaser,

(col. 4, line 55-col. 5, line 9, (matching identification to define more targeted audience]).

As per claim 47, Saxe discloses:

wherein the processing instructions for directing the computer to identify the at

least one other prospect list includes processing instructions for directing the computer

to identify, in the database, prospective customers having at least one attribute similar

to at least one attribute of at least one of the prospective customers from the successful

list of prospective customers for the first list purchaser, (Col. 11, lines 19-23, [similar

characteristics]).

As per claim 49, Saxe discloses:

further comprising processing instructions for directing the computer to

removing duplicate prospective customers from the targeted list of prospective

customers, (Col. 10, line 48, [eliminate duplicate list]).

As per claim 50, Saxe discloses:

further comprising processing instructions for directing the computer to

solicit feedback from the first list purchaser to evaluate success of the targeted

list provided to the first list purchaser, (Col. 6, lines 42-45, [shows directory's information

can come from local surveys)].

As per claim 51, Saxe discloses:

further comprising processing instructions for directing the computer to

store the feedback from the first list purchaser in the computer database, (Col. 6, line

37, [shows survey information is updated in the directory]).

As per claim 52, Saxe discloses:

Wherein identifying a successful list of prospective customers for the first list

purchaser Is based on the feedback from the first list purchaser stored in the computer

database, (Col. 8, lines 48-65, [shows that viewers {subscribers} may interface with the

cable medium in order to interact where appropriate, and responses are captured on a

file server, thereby allowing viewer {subscriber} access to this response information. In

addition, the subscriber responses provided represents feedback, and the list of

respondees to targeted advertisements identified by a buy number who desire product

information indicates a successful list]).

Response to Arguments

7.   Applicant's arguments filed 6/27/05 have been fully considered but they are not persuasive.

The applicant argues that the Applicant's system can identify which other advertisers had previously used a list that one advertiser has used successfully, determine what other lists those other advertisers had used successfully, and since advertisers in a particular industry or trade tend to target similar customers, recommend those lists to that first advertiser. The applicant then argues that the neither the Saxe, Heinly nor Wright references disclose taking the characteristics of a customer list that a given advertiser has successfully used and employing them as a basis for identifying other lists, nor do they describe (according to applicant) associating prospect lists with data that are based on input from corresponding list purchasers and indicate whether such lists were successful for those list purchasers. The applicant argues that the Saxe reference merely describes compiling a list from an already selected list and does not teach how to select the lists. However, Saxe discloses an example where American Express desires to upgrade existing regular or "green" card subscribers to the premium or "gold/platinum" cardholders. The American Express card company does this by generating an American Express cardholder profile using a list of American Express cardholders, and then creating a target list by "matching" the cardholder profile with a list of consumers having similar characteristics as shown in col. 11, lines 8-23. In this case, the list of green card subscribers is analogous to a successful list because these card subscribers have already successfully completed the card application process, and

already have the credit card. American Express then uses these lists of people they

have already successfully signed up for the card to create an upgraded list. In addition,

since the non-cardholding (of gold cards) list of individuals are matched against a list of

consumers (who are gold card holders and are part of the successful list) having similar

characteristics to generate a list of non-card holders who would be eligible to have a

gold card (be on the successful list), then this shows that Saxe discloses associating

prospect lists with data that are based on input from corresponding list purchasers and

the indication of whether such lists were successful for those list purchasers is shown

by the presentation of new gold lists.

Conclusion

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Akiba K Robinson-Boyce whose telephone number is

571-272-6734. The examiner can normally be reached on Monday-Tuesday 8:30am-

5pm, and Wednesday, 8:30 am-12:30 pm.

         If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Hayes can be reached on 571-272-6708. The fax phone numbers for

the organization where this application or proceeding is assigned are 703-746-7238

[After final communications, labeled "Box AF"], 703-746-7239 [Official Communications],

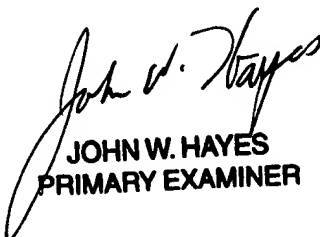and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-305-

3900.

A. R. B.
September 12, 2005

JOHN W. HAYES
PRIMARY EXAMINER